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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,075	11/06/2001	Johann Engelhardt	5005-1009	4876
23280	7590	10/25/2004	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC			FINEMAN, LEE A	
485 SEVENTH AVENUE, 14TH FLOOR				
NEW YORK, NY 10018			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/992,075	ENGELHARDT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lee Fineman	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 August 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2,4,6-8,10 and 11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4,6-8,10 and 11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 January 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 8/5/04.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

This Office Action is in response to an amendment filed 5 August 2004 in which claims 1 and 7 were amended and claim 5 was cancelled. Claims 1-2,4, 6-8 and 10-11 are pending.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yano, U.S. Patent No. 5,701,197.

Yano discloses an arrangement (figs. 1 and 2) for visual and quantitative three-dimensional examinations of specimens comprising a stereomicroscope (1) with an objective (15), a first and second eyepiece (35a, 35b) wherein the objective and the first and second eyepiece defines a first and a second observation beam path (fig. 2), a tube lens (11) disposed in at least one of the observation beam paths (fig. 1), a confocal scanning device (2) mounted to the stereomicroscope (column 4, lines 26-28) thereby providing a scanning beam path (fig. 1) wherein the scanning device scans a specimen (E) through the objective (15) and acquires data for a three-dimensional visual depiction of the specimen (column 3, line 67-column 4, line 2), an optical coupling-in element (18, 19, 20) configured to couple the scanning beam path into at least one of the observation beam paths at a coupling-in region (figs. 1 and 2), wherein the tube lens (11) is disposed between the coupling-in region (18, 19, 20) and the objective (15), and

wherein the first and second observation beam paths and the scanning beam paths are together imaged by the objective (15) of the stereomicroscope onto the specimen (E) to be examined.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yano in view of Hellmuth et al., U.S. Patent No. 5,795,295 or Carlsson et al., "Confocal Imaging for 3-D Digital Microscopy" in Applied Optics, Vol. 26(16), November 6, 1986, pp. 3232-3238.

Yano discloses the claimed invention except for wherein the stereomicroscope is equipped with a camera port at which the scanning device couples the scanning beam into the stereomicroscope, and wherein the scanning device is connected to a computer that analyses the image data acquired and displays them on a display. Using imaging devices, computers and displays are well known in the art for coordinating scanning in three-dimensions. For example, both Hellmuth (fig. 1) and Carlsson et al. (fig. 2) teach microscopes with equipped with a camera port (in so far as an imaging device is attached) at which the scanning device couples the scanning beam into the microscope, and wherein the scanning device is connected to a computer (500, Hellmuth or microprocessor, Carlsson) that analyses the image data acquired and displays them on a display (210, Hellmuth or TV, Carlsson). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a port, imaging device,

computer and display to the system of Yano to provide a more flexible system with better scanning control and a second sample viewing option.

***Response to Arguments***

5. Applicant's arguments filed 5 August 2004 have been fully considered but they are not persuasive.

Applicant argues that Yano does not teach or suggest the scanning beam path is imaged by the objective of the stereomicroscope onto the specimen to be examined (page 7, paragraph 2 of applicant's remarks). The examiner respectfully disagrees. A microscope objective is the optical element that receives light from the object and forms the first or primary image. In Yano, when the scanning unit is included in the stereomicroscope, lens 15 is the objective for the system (receiving the image from sample E). Therefore Yano does disclose wherein the first and second observation paths and the scanning beam path are together imaged by the objective of the stereomicroscope onto the specimen to be examined.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LAF  
October 18, 2004

  
MARK A. ROBINSON  
PRIMARY EXAMINER